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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,258	09/08/2000	Loren G. Knutson	068520.0111	3085

7590 03/15/2004
Baker Botts LLP
2001 Ross Avenue
Dallas, TX 75201-2980

EXAMINER

ALAM, SHAHID AL

ART UNIT PAPER NUMBER

2172

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/658,258

Applicant(s)

KNUTSON, LOREN G.

Examiner

Shahid Al Alam

Art Unit

2172

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Shahid Al Alam
Primary Examiner
Art Unit: 2172

DETAILED ACTION

1. Claims 1 – 24 are pending in this Office action.

Information Disclosure Statement

2. The information disclosure statement filed November 13, 2000, Paper number 2, is not considered because the references are co-pending application and are not in a FORM 1449, however, Examiner reviewed all of the co-pending application as listed. It has been placed in the application file.
3. The information disclosure statement (IDS) submitted on June 11, 2002, Paper No. 3 and on June 30, 2003, Paper No. 4 are being considered by the examiner.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 8, 13 and 20 recite the limitation “different” in the 3rd line. The term “different” is a relative term, which renders the claim indefinite. The term “different” is not defined within the claim and the specification does not provide a standard to measure a degree of “difference” or certainty. It is not clear from the claims whether “the definitions” are to be “different” from one another or “different” from other entities.

Appropriate correction is required.

Claims 2 – 7, 9 – 12, 14 – 19 and 21 – 24 are rejected under 35 U.S.C. 112, 2nd paragraph, as being dependent upon rejected independent claims 1, 8, 13 and 20 respectively.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 8, 13 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 of copending Application No. 09/658,016. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the same limitation.

The difference between claim 1 of the '016 application and instant claim is that instant claims do not recite "one of said function portion . . . information at said control port;" . . . "information which includes a definition . . . one function portion;" . . . "said preparing step includes . . . current state of the working information."

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to exclude the limitation "one of said function portion . . . information at said control port;" . . . "information which includes a definition . . . one function portion;" . . . "said preparing step includes . . . current state of the working information." because the remaining elements would have performed the same functions as before. "Omission of element and its function in combination is obvious expedient if the remaining elements perform same functions as before." See *In re Karlson* (CCPA) 136 USPQ 184, decide Jan 16, 1963, Appl. No. 6857, U.S. Court of Customs and Patent Appeals.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,848,198 issued to Alan Penn ("Penn") and in view of U.S. Patent Number 6,634,008 issued to Harry Dole ("Dole").

With respect to claim 1, Penn teaches a method for providing a set of predetermined function definition which are different (column 1, lines 10 – 20 and column 32, lines 31 – 48); and

preparing a project definition, said project definition including:

a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition (column 28, lines 31 – 48);

a further portion which includes a source portion identifying a data source and defining an output port through which data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which data can be supplied to the data destination (column 6, lines 60 – 67); and

binding information which includes binding portions that each associate a respective said input port with one of said output ports (column 19, lines 5 – 9; “binding information” is read on “header containing descriptive information”).

Penn does not explicitly teach data from said data source being transferred to said source portion through a network as claimed.

Dole discloses claimed data source being transferred to source portion through a network (column 6, lines 5 – 8; column 7, lines 59 – 60; Dole).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Dole with Penn, because combination would increase system reliability.

As to claim 2, configuring said network to include a portion of the Internet (column 9, lines 44 – 48; Dole).

As to claim 3, selecting locations for said data source and said source portion to be physically remote (column 6, lines 44 – 47; Dole).

As to claim 4, said data from said data source is in a compressed format; and including the step of causing said source portion to uncompress said data before outputting said data through said output port of said source portion (column 17, lines 8 – 20 and 43 – 54; Dole).

As to claim 5, the step of effecting said transfer of said data through said network in a manner conforming to a public communication protocol (column 5, lines 53 – 56; Dole).

As to claim 6, the step of selecting as said public communication protocol the eXtensible Markup Language (XML) protocol (column 7, lines 57 – 60; Dole).

With respect to claim 7, Dole teaches hypertext transfer protocol in column 5, line 55 and web server transfers data in column 6, line 5. However, Penn and Dole do not explicitly teach communication protocol is the File Transfer Protocol (FTP) as claimed.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use FTP since the File Transfer Protocol (FTP) is commonly used transfer protocol to transfer data.

Claims 8 – 12 are essentially the same as claims 1 – 7 except that it set forth the claimed invention as a computer readable medium rather than a method and rejected for the same reasons as applied hereinabove.

The subject matter of claims 13 – 19 are rejected in the analysis above in claims 1 - 7 and these claims are rejected on that basis.


Claims 20 – 24 are essentially the same as claims 13 – 19 except that it set forth the claimed invention as a computer readable medium rather than a method and rejected for the same reasons as applied hereinabove.

Contact Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (703) 305-2358. The examiner can normally be reached on Monday-Thursday 8:00 A.M. - 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Shahid Al Alam
Primary Examiner
Art Unit 2172

5 March 2004